

**REMARKS**

In response to the Office Action of May 8, 2006, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-30 are pending in this application. By this Amendment, Claims 1 and 20 have been amended to further define the invention by including that the combinatorial lubricating oil composition library comprises a vast number of a plurality of different lubricating oil compositions. Support for this amendment can be found throughout the specification, e.g., page 3, lines 8-15. Applicants therefore respectfully submit that no new matter has been added to this application. Moreover, it is believed that the claims as presented herein places the application in condition for allowance.

The Examiner has provisionally rejected Claims 20 and 22-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,510. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 20 and 22-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,507. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 20, 22-24 and 26-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,508. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has provisionally rejected Claims 1 and 17-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

The Examiner has rejected Claims 1-3, 8-11 and 16-19 under 35 U.S.C. §102(e) as being anticipated by Carey et al. U.S. Publication No. 2004/0144355 ("Carey et al.").

Carey et al. disclose a marine diesel engine system containing a slow-speed cross head marine diesel engine with at least one cylinder; and cylinder lubricant components proximate to the engine and containing (a) a primary lubricant and (b) an additive selected from (i) an alkylamine-alkylphosphate having at least 1.25 equivalents of alkylamine to 1.0 equivalents of alkylphosphate, (ii) 500 TBN calcium sulfonate, and (iii) mixtures thereof. Carey et al. further disclose in Example 2 storage stability data for six different lubricating oil compositions. As set forth in Table II in Carey et al. the six different lubricating oil compositions each contain the same base oil and either (1) no additive (Comparative Example 2); (2) calcium sulfonate as the additive in varying amounts (Example 2 and Comparative Examples 3 and 4); (3) magnesium sulfonate as the additive (Comparative Example 5) or (4) calcium phenate as the additive (Comparative Example 6).

In contrast to the presently claimed invention, Carey et al. fail to disclose or suggest a combinatorial lubricating oil composition library comprising “a *vast number of a plurality of different lubricating oil compositions* comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) at least one lubricating oil additive” as presently recited in amended Claim 1. Thus, the presently recited combinatorial library, as set forth in the present claims, contains many different lubricating oil compositions including many different base oils each of varying types and/or amounts and many different lubricating oil additives also each of varying types and/or amounts. Moreover, the definition of “vast”, as set forth in The American Heritage Dictionary, Houghton Mifflin Company, Second College Edition, (1991) page 1339 (Exhibit 1), states that vast means “[v]ery great in size, number, amount, or quantity”. Carey et al. on the other hand simply disclose storage stability data for six different lubricating oil compositions as set forth in Table II therein. Certainly, the lubricating oil compositions set forth in Table II of Carey et al. cannot be considered a vast number of a plurality of different lubricating oil compositions. Thus, Carey et al do not disclose all of the elements and limitations of the claimed invention.

In the Office Action, it is the Examiner’s belief that Carey et al. still anticipates the presently recited claims because Carey et al teach a plurality of different lubricating oil compositions, wherein each composition contains a primary lubricant base oil of lubricating viscosity and a different additive. The Examiner goes on to state that Example 2 in Carey et al. teach a series of lubricating oil compositions that all are very similar to one another in that they each contain TBN 40 marine engine oil and a different TBN additive or a different amount of additive. Thus, according to the Examiner, “[s]uch a series of lubricating oil compositions

constitutes a 'combinatorial library' as known to one of ordinary skill in the art, and meets the limitation in the amended claim of a "diverse number of a plurality of different lubricating oil compositions comprising a major amount of at least one base oil of lubricating viscosity and at least one lubricating oil additive". This wholly unsupported assertion cannot possibly serve as a basis for this rejection. It is well established that, for a claim to be anticipated, a single prior art reference must disclose each and every element of the claimed invention, either expressly or inherently. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987); *cert. denied*, 484 U.S. 1007 (1988). As Carey et al do not disclose all of the elements and limitations of the claimed invention, unquestionably, then, the presently claimed combinatorial lubricating oil composition library recites novel subject matter over Carey et al.

For the foregoing reasons, amended Claims 1-3, 8-11, 16-19 are believed to be patentably distinct over Carey et al. and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

The Examiner has rejected Claims 1-2, 8-10 and 16-26 under 35 U.S.C. §102(e) as being anticipated by Kolosov et al. U.S. Publication No. 2004/0123650 ("Kolosov et al."). This rejection is respectfully traversed.

Nowhere does Kolosov et al. disclose or suggest a combinatorial lubricating oil composition library comprising "a vast number of a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) at least one lubricating oil additive" as presently recited in amended Claim 1. Nor does Kolosov et al. disclose or suggest a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising (a) providing a library of

a vast number of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive, each sample being in a respective one of a plurality of test receptacles; (b) measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and, (c) outputting the results of step (b) as presently recited in Claim 20.

Rather, Kolosov et al. simply disclose a system and method for screening a library of a multitude of genera of material samples for rheological properties one of which may be a lubricant. However, a lubricant can be a grease, jelly, e.g., K-Y jelly, as well as powders, e.g., dry graphite, PTFE, etc., formulated with water and can be used as is such that all lubricants may not even require an additive or, for that matter, be used in a lubricating oil composition. Kolosov et al. provide no disclosure that a lubricant can even be a base oil of lubricating viscosity for use in a lubricating oil composition much less a vast number of a plurality of different lubricating oil composition samples comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) at least one lubricating oil additive. Applicants therefore respectfully disagree with the Examiner's statement on page 11 of the Office Action that "the teachings within Kolosov et al. are identical to what is currently being recited in these claims." As set forth above, the presently claimed combinatorial lubricating oil composition library and method for its preparation are different than the system and method disclosed in Kolosov et al. Thus, Kolosov et al do not disclose all of the elements and limitations of the claimed invention. Accordingly, Claims 1, 2, 8-10 and 16-26 clearly possess novel subject matter relative to Kolosov et al. and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

The Examiner has rejected Claims 4-7 and 12-15 under 35 U.S.C. §103(a) as being obvious over Carey et al.

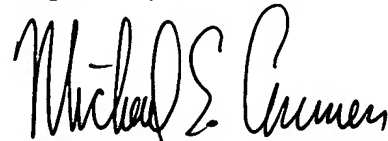
The foregoing deficiencies of Carey et al. discussed above with respect to the rejection of Claim 1, from which Claims 4-7 and 12-15 ultimately depend, apply with equal force to this rejection. At no point is there any suggestion, motivation or even a hint in Carey et al. of providing a combinatorial lubricating oil composition library comprising a vast number of a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive as presently recited in amended Claim 1, from which Claims 4-7 and 12-15 ultimately depend. Instead, Carey et al. merely disclose a lubricating component for marine diesel engines which includes a marine diesel engine lubricant as the primary lubricant and an additive such as a detergent, an antioxidant, a dispersant, a demulsifier, a defoamant or an antiwear additive. Moreover, there must be some teaching or suggestion within the reference, or within the general knowledge of one skilled in the art, to arrive at the claimed invention. Certainly, nothing in Carey et al. would lead one skilled in the art to modify the lubricating component for marine diesel engines disclosed therein and arrive at the presently recited combinatorial lubricating oil composition library. Accordingly, Claims 4-7 and 12-15 are believed to be nonobvious, and therefore patentable, over Carey et al. and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

The Examiner has rejected Claims 27-30 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. in view of Smrcka et al., European Patent No. 1233361 ("Smrcka et al.").

The foregoing deficiencies of Kolosov et al. discussed above with respect to the rejections of Claim 20, from which Claims 27-30 ultimately depend, apply with equal force to this rejection. Smrcka et al. does not cure and is not cited as curing the above-noted deficiencies of Carey et al. and Kolosov et al. Rather, Smrcka et al. is merely cited for its disclosure of storing test results in a data carrier. Accordingly, Claims 27-30 are believed to be nonobvious, and therefore patentable, over Kolosov et al. and Smrcka et al.

For the foregoing reasons, amended Claims 1-30 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen". The signature is fluid and cursive, with the first name "Michael" and last name "Carmen" being clearly legible.

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